Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte A. TODD LEAK, APIROMRAJ S. ROSLANSKY,
PAUL T. VAN GOMPEL, GEORGIA L. ZEHNER,
EDWARD H. RUSCHER, and YUNG HSIANG HUANG

Appeal No. 2000-0921
Application No. 08/366,090

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-54, all the claims pending in the application.

Appellants' invention pertains to a mechanical fastener tab suitable for use on a disposable absorbent product (claims 1-11), wherein the fastening tab comprises a substrate and a first

mechanical fastener component[1] joined to the substrate, with the fastening tab having a Gurley stiffness value[2] of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component. Appellants' invention also pertains to a disposable product (claims 12-33 and 54) and to a disposable absorbent product (claims 34-53) comprising a mechanical fastening tab as described above. According to appellants, mechanical fastening tabs in accordance with the invention have improved flexibility. A further understanding of the claimed invention can be derived from a reading of exemplary claim 1, which appears in the appendix to appellants' brief.

The references applied in the final rejection are:

Flug et al. (Flug)	5,401,275	Mar. 28, 1995 (filed Sept. 11, 1991)
Roessler et al. (Roessler)	5,176,670	Jan. 5, 1993

[1]As stated on page 6 of appellants' specification, "a first mechanical fastener component is intended to refer to a material which is adapted to mechanically interlock with a second material. . . . In the illustrated embodiment, the first mechanical fastener component is the hook portion of a hook-and-loop fastener."

[2]Reference is made to pages 17-18 of appellants' specification for an explanation of a suitable technique for determining Gurley stiffness values.

Claims 1-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roessler in view of Flug. The examiner states (final rejection, page 2):

> Roessler teaches all aspect[s] of the claimed invention except for the specific Gurley stiffness values and substrate overlay of 2%-98%.[3] The Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same. The Gurley stiffness values recited in applicants' specification, even though performed in a standard testing machine, are considered useless for comparison purposes to the prior art. The Gurley stiffness values can vary depending to sample size and other factors. Even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values due to different testing procedures.

The examiner further considers (final rejection, page 3) that substrate overlayment of from about 2% to about 98%, as called for in claims 8 and 20, is taught by Flug, and that it would have been obvious in view of this teaching to provide a similar overlayment arrangement in Roessler. The examiner contends (final rejection, page 3) that the rejection is proper because "[a]pplicants have not sufficiently demonstrated that the fastening tab of Roessler will not meet the test value of applicants' invention when tested in accordance to applicants' test method."

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[3]The requirement that the substrate overlays from about 2 to about 98 percent of the planar surface of the first mechanical fastener component is found only in dependent claims 8 and 20.

Discussion

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki,* 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In making a rejection on the ground that claimed subject matter would inherently be present in the apparatus or process described by a reference, the examiner bears the initial burden of making out a *prima facie* case, as by providing a basis in fact and/or technical reasoning which reasonably supports the position that what is allegedly inherent would necessarily flow from the teachings of the prior art. *See Ex parte Levy,* 17 USPQ2d 1461, 1464 (BPAI 1990) and the cases cited therein. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1990).

The main issue in this case is whether Roessler discloses a fastener tab comprising a substrate and a mechanical fastener component wherein the tab has a Gurley stiffness value of less than about 1000 milligrams in the area of the tab that includes the mechanical fastener component. Because we do not agree with the examiner that the claimed invention necessarily flows from the

disclosure of Roessler, we will not sustain the examiner's rejection.

The Roessler reference cited by the examiner against the appealed claims discloses, in pertinent part, a mechanical fastener tab 30 of the hook-and-loop type that is suitable for use on a disposable absorbent product. Beginning at column 6, line 29, and continuing to column 9, line 2, Roessler goes into considerable detail concerning the nature of the hook material and the loop material components of the mechanical fastener; however, it is not disputed that Roessler makes no mention whatsoever of the Gurley stiffness value of any of these fastener tab components. Nevertheless, the examiner takes the position that "[[t]he Roessler article comprises similar materials as recited in applicants' invention, therefore the Gurley stiffness value is considered to be the same [as that recited in the claims]" (final rejection, page 2). We surmise from this that the examiner considers the teachings of Roessler at, for example, column 6, line 29, through column 7, line 13, to be of such kind that a fastener tab having the claimed Gurley stiffness value would necessarily flow from making a fastener tab in accordance with these teachings.

In our view, the examiner has provided no basis in fact and/or technical reasoning which reasonably supports the above stated

theory of inherency. More particularly, we find appellants' reasoning on pages 3-4 of the brief, which the examiner has not even attempted to refute, as to why the allegedly inherent Gurley stiffness value does *not* necessarily flow from Roessler's teachings to be persuasive. In brief, appellants argue that while the hook material described by Roessler appears to be like the hook material described on page 18 of appellants' specification in connection with example 1, this alone is not enough to establish that the area of the fastener tab in question[4] necessarily has a Gurley stiffness value within the claimed range. In that appellants' specification clearly points out[5] that the Gurley stiffness value at the claimed area is influenced by the physical properties of both the hook material *and* the substrate, appellants' argument is well taken. In addition, and as aptly pointed out by appellants on page 4 of the brief, fastener tabs made using the hook material described on page 18 of appellants' specification, which material is akin to that disclosed in Roessler, may or may not fall within the claimed Gurley stiffness value depending on the characteristics of the

[4]That is, the area of the fastening tab that includes both the hook material and the substrate.

[5]See, for example, page 7, line 18, through page 8, line 15, and page 9, lines 6-15, of appellants' specification.

substrate. In light of this well reasoned argument, the examiner's unvarnished position to the effect that the claimed subject matter would necessarily result from using Roessler's hook material simply because the hook material of the reference is similar to that used by appellants in making the claimed invention cannot be sustained.

We are likewise in agreement with appellants that there is no factual basis for the examiner's contention (final rejection, page 2; answer, pages 3-4) that Gurley stiffness values can vary from sample to sample, such that even if Roessler stated a Gurley stiffness value, there would be no way to correlate a Roessler value with the claimed values. The examiner's contention (final rejection, page 3; answer, page 4) that the burden is on appellants to prove that the fastening tabs of Roessler will not have a Gurley stiffness value within the claimed range is simply wrong. *See In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444.

We have also considered whether Roessler would have rendered obvious a fastener tab having a Gurley stiffness value of less than about 1000 milligrams in the area of the fastening tab that includes the first mechanical fastener component, but find nothing

in Roessler that would have suggested the claimed subject matter. Further, the examiner does not contend, and it is not apparent to us, that Flug makes up for the deficiencies of Roessler in this respect.

In view of the foregoing, the examiner's rejection of claims 1-54 as being unpatentable over Roessler in view of Flug cannot be sustained.

The decision of the examiner is therefore reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN P. McQUADE Administrative Patent Judge	)	

LJS/lp

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